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SERIAL NO. 10/792,319
JUTTU, SMITH

PATENT APPLICATION
STC-03-0009

REMARKS

Claims 3, 5 and 14 are rejected under 35 USC §112 and Claims 1-5 and 8-14 are rejected under 35 USC §103. The applicants respectfully traverse these rejections and request reconsideration of the application in view of the amendments and the remarks filed in the response mailed September 1, 2006, and the following remarks and arguments.

Should the examiner be of the opinion that the claimed process is not commensurate in scope with the process exemplified in the examples, the applicants respectfully point out that the claimed process is for aromatization of hydrocarbons by contacting an alkane containing 2 to 6 carbon atoms per molecule with a catalyst consisting essentially of platinum deposited on a zeolite consisting essentially of gallium and silicon in the framework wherein the catalyst has been treated first with hydrogen, second with a sulfur compound, and then again with hydrogen. While the claimed process is demonstrated in the Examples with aromatization of propane with a Pt/ZSM-5 catalyst, the claimed process need not be limited to the embodiments in the examples.

[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. *See, e.g., Nazomi Communications, Inc. v. ARM Holdings, PLC*, 403 F.3d 1364, 1369 [74 USPQ2d 1458] (Fed. Cir. 2005) (claims may embrace "different subject matter than is illustrated in the specific embodiments in the specification"); *Liebel-Flarsheim*, 358 F.3d at 906-08; *Teleflex*, 299 F.3d at 1327; *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 [227 USPO 577] (Fed. Cir. 1985). In particular, we have expressly rejected the contention that if a

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patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. *Gemstar-TV Guide*, 383 F.3d at 1366.

Phillips v. AWH Corp., 75 USPQ2d 1321, 1334 (CAFC 2005)

The applicants have a reasonable technical basis for believing that their invention is applicable to zeolite catalysts other than ZSM-5 and to alkanes other than propane. There is a certain amount of predictability in chemistry, even catalysis. There has been no evidence advanced by the examiner to support the contention that catalysts and alkanes within the scope of the claims would not produce comparable results to those shown by the data. The ultimate legal conclusion of obviousness must be based on facts of record, not on an unsupported statement by the examiner. If the examiner is asserting that the claimed process is not commensurate in scope with the examples, such an assertion must be supported by evidence or reasoning substantiating the doubt so expressed. In re Dinh-Nguyen et al, 181 USPQ 46 (CCPA 1974); In re Bowen, 181 USPQ 58, (CCPA 1974).

Testing a portion of a claimed class is sufficient since the applicant need not demonstrate superior results in every environment in which the claimed invention is used. In re Chupp, 816 F2d 643; 2 USPQ2d 1437 (CAFC 1987). The court also noted in Chupp that though the rejection was couched in the language of obviousness, it was actually one based on "undue breadth". As in Chupp, the examiner in the present case is apparently attempting to resurrect the discredited "undue breadth" rejection by camouflaging it as a rejection based on the claims not being commensurate in scope with the examples.

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The applicants note that the examples of the cited reference Chu used a catalyst of a ZSM-5 zeolite and a feed of n-hexane (Examples 1-3, col. 10, line 7, through col. 11, line 50), yet Claim 1 of Chu is for a "catalyst comprising a crystalline zeolite" and a "feed containing at least 50 weight percent of C₃ to C₁₂ aliphatic hydrocarbons". The United States Patent and Trademark Office has issued patents with claims broader than the examples of the disclosure and should be consistent in its actions.

The Commissioner is hereby authorized to charge any additional fees due by filing this paper or to credit any overpayment to Account No. 502025. On the basis of the above remarks, reconsideration of this application is requested and its allowance of the claims is requested at the examiner's earliest convenience. No new matter has been added.

Respectfully submitted,



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